In the Supreme Court of the United States

OCTOBER TERM, 1960.

No. 272.

SQUEEZE-A-PURSE CORPORATION,
Petitioner,

vs.

BENJAMIN STILLER, *et al.*,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION.

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COUNTER-STATEMENT OF QUESTIONS PRESENTED FOR REVIEW.

1. In view of the requirement that a "case or controversy" must be shown, may petitioner use a hypothetical fact situation, different from the case at bar, to obtain a ruling on whether the standard of invention has been lowered by Section 103 when the case at bar does not present such issue?

2. Where the case of *Great Atlantic & Pacific Tea Co. v. Super-Market Equipment Corp.*, 340 U. S. 147 held that invention was lacking both because no "new" elements were involved and because the combination of "old" elements did not yield "unusual or surprising consequences," may Petitioner question whether the Trial and Appellate Courts in the present case followed the "criteria" of the

aforesaid *A. & P.* case, where the Trial Court found that "new" elements *did* exist *and* that said elements combined with the old elements to form a "unique and unitary" combination, and where such findings were affirmed by the Court of Appeals?

3. May a Petitioner seek review on the basis that the anticipatory effect of prior patents was "given little or no weight" by the Trial Court where the Trial Court specifically stated that "* * * *aside from the weakness of non-use* the prior art patents relied upon do not, in my judgment, constitute an adequate defense to validity * * *"? (Emphasis added.)

COUNTER-STATEMENT OF THE CASE.

Petitioner's statement of the background appears merely to be a plea for sympathy, which has no bearing on the questions presented for determination. Moreover, some of the statements, particularly those reciting irregularities and bad faith in the securement of the reissue are erroneous. Significantly no reference to the record appears for supporting such statements.

The statement that the patent owner did not sue Petitioner, thus compelling Petitioner to seek a declaratory judgment is misleading, because factually prior to the filing of such action, the patent owner had sued the Ohio Drug & Specialty Co. in the District Court for the Northern District of Ohio, for selling Petitioner's product, but Petitioner did not enter an appearance in defense of that action. Consequently, a consent decree was obtained and a permanent injunction was issued against the Ohio Drug & Specialty Co. for making, using or selling infringing articles manufactured by Petitioner.[1] (17b)

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[1] The designation b means the appendix of Respondent in the Appellate Court.

Reissue Patent 24,166 was issued June 12, 1956, with eight claims. Claims 1 to 5 of the reissue patent are identical to claims 1 to 5 of original Patent 2,667,906.

The reissue application was filed February 1, 1956, and called the attention of the Patent Office to the following patents:

a. Meier United States Patent 2,125,354

b. Butler United States Patent 2,086,378

c. Nelson United States Patent 2,278,088.

The reissue patent was granted over these patents by the Patent Office and the attention of the Court is respectfully directed to the fact that Butler and presumably Nelson are the prime references noted by the Petitioner in support of this petition.*

The infringement complained of in this case is, in the words of the Trial Judge (50a).

"* * * better than a Chinese copy. * * *"

Such finding was correct because the Petitioner's executive officer, Nathan Silverman, upon seeing the patented item of the Repondent, merely gave instructions to "* * * make up a purse like this Quick-Coin * * *" (19b). The infringing item has never deviated from the exact duplication originally introduced.

The trial of this case was conducted before the Honorable Paul Jones of the United States District Court for the Northern District of Ohio, Eastern Division, on March 23 and 24, 1959.

Opposing expert witnesses gave conflicting testimony as to the prior art. On May 27, 1959, the District Court rendered its opinion reproduced in Petitioner's Appendix in the Court of Appeals (159a).

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* Reference is erroneously made on page 6, line 8 of the petition to a "Fulton" patent. There is no such patent in the record of this case.

Respondents contend that the Trial Court opinion made the following factual conclusions:

"—As to invention:

1. Claim 3 constitutes invention.

2. The defendant's article is made up of a unique and unitary combination of old elements and new and useful elements which constitutes a definite advance.

—As to the prior patents:

1. Nothing in the prior art patents relied upon clearly demonstrates or discloses the unitary character of claim 3.

2. Neither the material used nor the structure of the earlier prior art patents disclose the original adaptable structural features and elements which characterize the practical, clean-cut and operable art of the defendant's purse.

3. There are some disclosures of certain functional features in the prior art patents but their object and purpose were not directed in each case to the same operable elements as those of the defendant's purse.

4. None of the earlier patents read on or disclose the features of the elements and features of the defendant's purse.

5. Aside from the weakness of non-use, the prior art patents relied upon do not constitute an adequate defense for validity and infringement of the defendant's patented article.

—As to the paper status of the prior art:

1. Paper patents are considered not as anticipation but as testing the novel character of the challenged patent as an advance over the earlier disclosure.

—As to the validity of the patent:

1. The defendant's patent is valid and infringed."

The District Court in finding validity analyzed the elements of Claim 3 of the Patent in suit and found that two of the elements designated "F" and "G" in the decision were new and also found that all of the elements were arranged in a unique and unitary combination. (160a and 161a.) Such holding on invention was preceded by a specific request by the court at the completion of the trial, for counsel to provide briefs on the following questions:

1. Was there invention in the Defendant's product?

2. What was the pertinent prior art?

3. The effectiveness of earlier art as anticipation where there was no commercial use or manufacture. (160a.)

Pursuant to the foregoing request the questions were fully briefed by counsel, hence the finding of the Court must be accepted as a result of a careful consideration of the factual question as to the presence or absence of elements in the prior art of record. The affirmance by the Court of Appeals should justify the conclusion that the findings were presumptively correct and were predicated upon the correct rule of law.

It is clearly apparent from Petitioner's statements at pages 5 and 6 under the heading "The Decision Below" that Petitioner seeks to premise its argument as to elements "F" and "G" by considering them out of context with the remaining portion of claim 3. When read in context with the remaining portion of the claim it is clear that elements "F" and "G" are not old in the art. Thus element "F" recites "said envelope" and hence refers back to the element which defines the envelope. Element "D" recites the envelope as having "a substantially closed slit *in one face*" (Emphasis added). Each prior art patent lacks element "D."

Similarly element "E" defines the slit as "extending from one periphery to an opposite periphery," thus meaning that the slit extends "in one face" from one periphery to an opposite periphery. Each prior art patent lacks element "E." Accordingly, when element "F" defines the envelope as having "oppositely disposed through apertures," and when element "G" defines the "slit" as communicating with the respective apertures, the elements "F" and "G" take on a different meaning from that which Petitioner seeks to convey. The Trial Court fully understood such distinction, and was therefore justified in holding that the elements "F" and "G" when considered with the remaining elements resulted in an article made up of a "unique and unitary combination of old elements with new and useful elements" (161a).

Moreover, the fact that the Court found (161a) that the elements "F" and "G" constitute "one of the prime novelties of the article" is no admission by the Court that all the preceding elements are old. Most certainly there is no "finding" by the District Court that all such elements "A" to "E" are "old." Likewise, there is no admission either by Respondents' Counsel or by Respondents' Expert Witness that elements "F" and "G" are "old."

Petitioner's statement at page 6 that the Courts below rejected prior art patents because they "had not been proven by the Petitioner" is factually incorrect. It is obvious from a reading of the opinion by the Trial Court that the patents were considered either specifically and by name (162a, lines 19 to 27), or by definition—which would include Butler Patent No. 2,086,378 (162a, lines 11 to 18).

When read in context it is clear that the Trial Court relied upon the testimony of the witness De Jong only for knowledge as to what features would constitute an ad-

vance in the art from the viewpoint of salability of the article. The statement that Respondents have "abandoned the Court's opinion on this point" is denied.

ARGUMENT.

REASONS FOR DISALLOWANCE OF THE WRIT.

Respondent respectfully calls the attention of the Court to the fact that Petitioner at pages 9, 10 and 12 has rephrased the "Questions Presented" (at pages 2 and 3) so that when one reads the argument in support of the question one is under the impression that an entirely *different* question is before the Court. Such practice enables Petitioner to give the impression that much bigger, weightier and more generic questions are being presented for consideration—questions which are raised neither by the "questions presented" nor by the facts of record in the case. In fact, as Respondent shows *infra*, *not one* of the questions set forth by Petitioner, either in the original statement or in the flagrantly misleading restatement thereof preceding the argument, is raised by the facts of the present case.

Petitioner sets up straw-men questions, such as, that the Bench and Bar require a "clear-cut, unequivocal expression of opinion and direction by this Court" as to the standard of invention set forth by Section 103, without mentioning that the facts of the present case do not raise the question. This cavalier treatment of facts continues at the crucial points of Petitioner's brief, wherein Petitioner sets forth as "facts" statements which are completely unsupported by the record, as well as misstatements of the clear language of the Trial Court's opinion. These latter points will be discussed *infra* as they appear in order. Suffice it here to say that Petitioner's need to

resort to distortion, and "blowing up" of the questions presented is but one of many indications that Petitioner is attempting to bring a sham case before the Supreme Court, by framing questions which, though perhaps interesting in the abstract, are not properly before this Court.

As to the First Question.

Petitioner's "first" question as stated in the section entitled "Questions Presented for Review," page 2, is as follows:

> "1. Have the standards for determining the presence or absence of invention in any given patent been so changed by the Patent Act of July 19, 1952, Title 35, U. S. C., section 103, as to validate a patent on a combination of old elements, no one of which elements performs any new, different, unusual or unexpected purpose or function in the combination?"

No argument of any kind is submitted at pages 9-10 in support of the question. The discussion at pages 9-10 is limited to allegations that there is a conflict among the circuit courts as to the standard of invention set forth by Section 103. The mere statement that a conflict exists among the circuits on a point of law is not sufficient to entitle a case to be heard by the Supreme Court of the United States. In addition it must be shown that the case for which certiorari is sought actually raises the issue posed by the question. Article III, Sec. 2, Cl. 1 of the Constitution of the United States requires that there must be a "case or controversy."

In re Summers, 325 U. S. 561, 567;
Railway Mail Assn. v. Corsi, 326 U. S. 88, 93;
United States v. State of California, 332 U. S. 19, 24, 25;

International Longshoremen's and Warehousemen's Union Local 37 et al. v. Boyd, 347 U. S. 222, 223, 224.

Nor could such a showing have been made. The question posed by Petitioner asks for a ruling as to the standard of invention where only "old" elements are involved—yet the Trial Court found that "new" elements were present in the instant case. Petitioner also asks for a ruling on a combination of "old elements" no one of which elements performs any new, different, unusual, or unexpected purpose or function"—yet the Trial Court found that the combination of old and "new" elements was "unique and unitary."

35 U. S. C. 103 is correctly reproduced as follows:

"Conditions for patentability—Non-obvious subject matter.—A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. (July 10, 1952, c. 950, 1, 66 Stat. 798.)"

The Petitioner concedes, on page 9 of its petition, that the First, Third, Fifth, Seventh and Ninth Circuits have consistently held that 35 U. S. C. 103 did no more than codify the existing case law on the question of "invention."

Thus, the standard of invention established by *Hotchkiss v. Greenwood*, 52 U. S. 248, (11 How. 248), is acknowledged to be in effect. The petitioner states, however,

that the Second and Sixth Circuits have held differently but Respondent submits that this is not correct.

The Second Circuit, speaking recently through Chief Judge Clark in *E. J. Brooks v. Stoffel Seals Corp.* (C. C. A. 2, 1959), 266 F. 2d 841, 121 U. S. P. Q. 333, held as follows (121 U. S. P. Q. 335):

> "Clearly Lyon v. Bausch & Lomb Optical Co., 2 Cir., 224 F. 2d 530, 106 U. S. P. Q. 1, certiorari denied Bausch & Lomb Optical Co. v. Lyon, 350 U. S. 911, 107 U. S. P. Q. 362, does not support it; that case in fact recognizes 'the continued authority' of Hotchkiss v. Greenwood, 11 (2) How. (52 U. S.) 248, 267, and its requirement that the improvement over the prior art must be more than would be obvious to a person having ordinary skill in the art. And that test is definitely and expressly carried over to the Patent Act of 1952, 35 U. S. C. 103.[5] "

This clearly contradicts the statement of the Petitioner as to the law of the Second Circuit with respect to interpretation of 35 U. S. C. 103.

With regard to the Sixth Circuit, it should be noted that, in fact, the Sixth Circuit was one of the first circuits to speak out and interpret the effect of the 1952 Patent Act and particularly Section 103 thereof.

On April 19, 1953, Judge McAllister, speaking for the Court in *General Motors Corp. et al. v. Estate Stove Co.* (C. C. A., 1953), 201 F. 2d 645, 96 U. S. P. Q. 62; rehearing 203 F. 2d 912, 97 U. S. P. Q. 88, cert. den. 346 U. S. 822, 99 U. S. P. Q. 490, stated as follows (97 U. S. P. Q. 90):

> "From the foregoing, it would appear that the new Act has done no more in this respect than to adopt the test of 'obviousness' which has, in the past, been enunciated by the Courts, and that it did not provide

a new test differing from that which has generally been followed in the adjudication of patent cases."

This rule has consistently been followed by the Sixth Circuit since this decision.

Bobertz v. General Motors Corp., 228 F. 2d 94, 107 U. S. P. Q. 338, cert. den. 352 U. S. 824, 111 U. S. P. Q. 466;

National Latex Products Co. v. Sun Rubber Co. (C. C. A. 6, 1959), · F. 2d ; 123 U. S. P. Q. 279, rehearing 274 F. 2d 224, 124 U. S. P. Q. 84, cert. den. U. S.

Further, the Tenth Circuit has recently adopted the similar view that the 1952 Act merely amounted to a codification of the existing law. *Blish, Mize, Silliman Hardware Co. et al. v. Time Saver Tools, Inc. et al.*, (C. C. A. 10, 1956) 236 F. 2d 913, 111 U. S. P. Q. 6.

Thus, it is clear that there is no disagreement between the various Courts of Appeals as to the effect and interpretation of the 1952 Patent Act. In fact, there is complete harmony and, accordingly, there is no need for the Petition to be granted for the resolution of a well settled point of law.

As to the Second Question.

The second question of Petitioner presented for review at page 3 is as follows:

"2. Has the Court of Appeals for the Sixth Circuit, in affirming on the memorandum opinion of the District Court, applied correct criteria for determining invention, as set forth in The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. (1950), 340 U. S. 147, 95 L. Ed. 162, 87 U. S. P. Q. 303?

The argument of the Petitioner on the second question is premised on the assumption that the Trial Court erroneously found the elements "F" and "G" to be new and novel.

This position on the part of the Petitioner has been challenged by the Respondent in the Counter-Statement of Facts and for the purpose of avoiding repetition in this argument, it suffices to say that the Trial Court, considering the elements "F" and "G", as limited and defined by the elements "D" and "E", made a specific finding that the elements "F" and "G", when read in context with the remaining elements of the claim, were new and novel.

Thus, the fact situation here presented is one where an article has been made up of *novel and unobvious* elements that were combined in a *novel and unobvious* way with old elements so as to produce a *novel and unobvious* combination.

It is again reiterated and emphasized that there is no "finding" of the Court that the elements A through E inclusive of claim 3 are old.

Novelty of certain of these elements *has at all times* been challenged and disputed.

Thus, there is presented for review a fact situation which differs materially from that which was presented in *Atlantic & Pacific* where all of the elements were old *and* were not combined in an unusual or surprising fashion.

The Sixth Circuit has spoken frequently on the standard of invention as set forth by the Supreme Court in *Atlantic & Pacific*.

In *General Motors Corp. et al. v. Estate Stove Co.* (C. C. A., 1953) 201 F. 2d 645, 96 U. S. P. Q. 62; rehearing 203 F. 2d 912, 97 U. S. P. Q. 88; cert. den. 346 U. S. 822, 99 U. S. P. Q. 490, Judge McAllister, speaking for an unanimous bench, stated, in declaring invalid certain patents, as follows (96 U. S. P. Q. 77):

"It is also to be observed that the District Court made no findings that the old elements constituting these patents performed any additional or different function in the combination than they performed out of it, and the absence thereof goes to the weight to be accorded the findings of patentability of the District Court. Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp., *supra*."

Later, in *Allied Wheel Products, Inc. v. Rude*, 206 F. 2d 752, 97 U. S. P. Q. 510, Judge McAllister again relied upon *Atlantic and Pacific* to invalidate a combination patent where old elements of the prior art were combined and where these old elements performed the same function in the combination as they had performed prior to being placed in the combination. Again the Court observed that the District Court had failed to find any novelty with respect to any of the elements or in the manner in which they were combined.

The doctrine of *Atlantic and Pacific* was even more emphatically interpreted by the Court of Appeals for the Sixth Circuit in *Bobertz v. General Motors Corp.*, *supra*. In such case, wherein the Sixth Circuit invalidated a patent on a transparent hood, Judge Martin again speaking for unanimous bench stated as follows (107 U. S. P. Q. 341):

"Any lingering doubt as to the intention of the Supreme Court to require strict rather than liberal construction of combination claims was certainly dispelled by its opinion in Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 154, 87 U. S. P. Q. 303, 306, where the majority opinion concluded that the standard of invention used in the lower courts was less exacting than that required where a combination was made up entirely of old components."

After discussing *General Motors v. Estate Stove Corp.*, *supra*, and Judge McAllister's opinion therein, the Court concluded as follows:

> "We are, however of the view that the principle stated in the Great Atlantic and Pacific Tea Co. case is not modified by the new Act, *but continues to be the law and is here controlling.*" (Emphasis added.)

The above language of the decisions of the Sixth Circuit clearly refute any statement that the Sixth Circuit is "currently applying a standard of invention relaxed considerably from that expressed in Atlantic and Pacific," as alleged by Petitioner.

The Trial Court in the present case found *both* that new elements were present, *and* that the combination was unique (161a). Thus, it is clear that the Trial Court applied the *A. & P.* case, but concluded that the two items which were lacking therein were present in the instant case. The Court of Appeals, following its long and uninterrupted practice of requiring that the high standards of the *A. & P.* case be followed, affirmed the decision. Thus there is no question here as to whether the Trial and Appellate Courts followed the criteria established by the *A. & P.* case.

As to the Third Question.

Petitioner's Third Question Presented for Review (at page 3) is as follows:

> "3. May clear disclosures of properly granted prior patents, offered as evidencing lack of invention in a patent in suit, be given little or no weight simply because the said prior patents were not proven *by the proponent* thereof to have been commercialized successfully?"

Petitioner's argument in support of the question at page 12 is as follows:

> "Thereupon, the courts below—in view of plaintiff-petitioner's failure to prove affirmatively that the prior patents had been successfully commercialized, although the leather pocket purse was admittedly still being made and sold—*gave no weight to the prior patents*, citing Republic Iron & Steel Co. v. Youngstown Sheet & Tube Co. (6 Cir. 1921) 272 Fed. Rep. 386." (Emphasis added.)

In stating that the *Appellate* Court "gave no weight" to the prior art, because of its paper status, Petitioner has made a blatant and inexcusable misstatement of the very fact on which he now seeks review—*i.e.* as stated by his question presented for review, whether the *Trial* Court committed prejudicial error in giving "little or no weight" to the prior art as anticipation *because Petitioner did not show they were operative*. Petitioner refers only to the Third question propounded by the Trial Court, and fails to quote the *First* question which was "Was there *invention* in the defendants' product?" (Emphasis added.) (160a.) This was a separate question from the third which related to the paper status of the patents and was answered separately from any consideration of the paper status of the patents. The Court states in its opinion (160a) as follows:

> "Suffice it to say that *aside from* the weakness of nonuse the prior art patents relied upon do not, in my judgment, constitute an adequate defense to validity. * * *" (Emphasis added.)

and again at page 162a:

> "Nothing in the prior art patents relied upon clearly demonstrates or discloses the unitary character of claim 3. Neither the material used, nor the structure of the earlier art patents disclose the original adaptable structural features and elements which characterize

> the practical, clean-cut and operable art of the defendants' purse. * * *"

In the next paragraph, the Trial Court acknowledged

> "* * * some disclosures of certain functional features in the prior patents. * * *"

but the Court noted that

> "* * * their object and purpose were not directed, in each case, to the same operable elements as those of the Defendant's purse. * * *"

Each of the references, except Butler, was specifically recited and analyzed by the Court, who, towards the end of the opinion, reached the following conclusion:

> "It is my judgment that none of these earlier patents read on or disclose the equivalents of the elements and features of the Defendant's purse."

It is hard to envision how a Court could have more lucidly rejected the prior art after according it the full weight that it was entitled to.

There is no conflict of authority in the several circuits regarding this question of law.

The law in the Sixth Circuit is, and always has been that the non-use of paper patents may not affect their value for anticipation purpose. *Trabon Engineering Corp. v. Dirkes* (C. C. A. 6), 136 F. 2d 24, 58 U. S. P. Q. 97; *Campbell v. Mueller* (1947), 159 F. 2d 803, 72 U. S. P. Q. 295; *Republic Iron & Steel Co. v. Youngstown Sheet & Tube Co.* (6 Cir. 1921), 272 Fed. Rep. 386; *Coats Loaders & Stackers, Inc. v. Henderson*, 233 F. 2d 915, 109 U. S. P. Q. 332; *Royal Patent Corp. v. Monarch Tool & Mfg. Co.* (1953), 203 F. 2d 299, 97 U. S. P. Q. 197.

With the reference to the Seventh Circuit, the Petitioner cites only *Hobbs v. Wisconsin Power & Light Co.*,

250 F. 2d 100, 105, as support for the proposition that the basic doctrine of *Pickering v. McCullough*, 104 U. S. 310, has been "whittled down." We submit that this is not the case and in support of such position we offer the following quotation from the *Hobbs* case appearing at 250 F. 2d 105:

> "The fact that prior patents have not been used commercially is relevant only insofar as it tends to indicate that the step from them to the patent in suit actually involved invention."

This is the precise manner in which the non-user or non-commercialization of the prior art was considered by the Trial Court in reaching its opinion.

Even more recent, is the following pronouncement of law on this point from *University of Illinois Foundation v. Block Drug, et al.* (C. C. A. 7, 1957) 241 F. 2d 6, 11; 112 U. S. P. Q. 204, 207, as follows:

> "As already noted, none of the prior art was reduced to commercial practice and this in spite of the long felt want for a dentifrice which would aid in the elimination of tooth decay. The statement of this Court in Ric-Wil Co. v. E. B. Kaiser Co., 179 F. 2d 401, 404, appears to be appropriate:
>
> 'The prior art upon which the Defendant now lavishes its praise was apparently permitted to lie dormant until the exigency created by a suit for infringement required its resurrection.'
>
> It is true, as Defendants pointed out, that major art, even though not reduced to practice, may be utilized to anticipate."

It is noteworthy of consideration by this Court that the attention of the Patent Office, in this case, was specifically directed to the *most pertinent of the prior art* that is now being so lavishly praised by the Petitioner.

The Trial Court gave full weight to the prior art and rejected it in toto.

This finding of fact was affirmed by the Sixth Circuit Court of Appeals, which obviously concluded that such full weight had been given to the prior art by the Trial Judge.

The foregoing argument has been directed to Petitioner's Third Question as stated at page 3 of the petition. It is noted, however, that the eye-catching "restatement" of the question in bold-faced type on page 12 sets forth an entirely different question, which is not relevant to the present fact situations presented by this case. It is further noted that much of the argument of Petitioner, particularly on pages 14-18 is devoted to the aforesaid irrelevant and improper question.

Thus it is apparent (1) that the facts of the present case fail to present a "case or controversy" with respect to the third question, and (2) that there is not even a controversy among the circuits. But even if the latter were true then, as in the first two questions, Petitioner may not set up a hypothetical question to provide a decision thereon.

CONCLUSION.

The questions presented by Petitioner are hypothetical and therefore present no "case or controversy" in this Court. The questions assume facts which are not present in the case at bar, and assert a conflict of authority between various Courts of Appeal which does not exist. Thus there is no unsettled law which confuses the Bench and Bar.

Stripped of its verbiage, this case presents simply one of wilful and deliberate copying of a patent which was found to be valid and infringed.

The Petition for a writ of certiorari should be denied.

Respectfully submitted,

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Of Counsel.